

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of claims 1-10, which are pending in the above-identified application. Claims 1-10 stand rejected. In view of the following discussion, Applicant submits that all pending claims are in condition for allowance.

Applicant submits herewith the Declaration of Heinrich Kladders (hereinafter referred to as the “Kladders Declaration”). Mr. Kladders (i) received a degree in chemical engineering from the “Technikerfachschule Duisburg” located in Duisburg, Germany in 1968; (ii) has been a chemical engineer for over 30 years; (iii) has been designing medicament distribution devices, including powder inhaler devices, aerosol devices, and related methods and tooling for over 25 years; and (iv) has extensive expertise reviewing and being involved in reviewing and evaluating numerous U.S. patents and pending U.S. patent applications in connection with patentability. (Kladders Declaration at paras. 2-4.) Based on Mr. Kladders aforementioned experience and training, Applicant submits that Mr. Kladders is well versed in what skilled artisans know as a matter of common knowledge and what they would understand from the teachings of a publication, such as a U.S. patent/application. (Kladders Declaration at para. 5.) Therefore, Applicant respectfully requests that the Examiner consider Mr. Kladder’s statements as evidence of record.

### **Withdrawal of Notice of Appeal and Request for Continued Examination:**

As aforementioned, Applicant submits herewith an RCE, and respectfully requests: (i) withdrawal of the June 16, 2009 Notice of Appeal; and (ii) re-opening of prosecution for the instant application.

### **Claim Rejections Under 35 U.S.C. §103(a):**

At pages 2-5 of the December 16, 2008 Office Action and in view of the Examiner’s remarks in the March 27, 2009 Advisory Action, the Examiner has rejected claims 1-7, 9, and 10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,947,118 (“the ‘118 patent”) in view of U.S. Patent No. 5,871,010 (“the ‘010 patent”) and in further view of U.S. Patent No. 5,472,143 (“the ‘143 patent”). Applicant respectfully traverses the Examiner’s rejection.

Independent claim 1 recites “sloped and/or tapered parabolic-shaped elevations and/or depressions in a repeating pattern of an egg-carton arrangement”. (Emphasis added.)

Applicant respectfully acknowledges the Examiner’s concession that the ‘118 patent does not disclose or suggest elevations and/or depressions as recited in independent claim 1 of the instant application.

The Examiner alleges that it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the device of the ‘118 patent with the depressions taught by the ‘010 patent in order to result in the present invention as claimed in the instant application. The Examiner alleges that the only difference between the indentations of the ‘010 patent and the depressions of the instant application is the shape, and that changing the shape of the indentations/raised areas of the ‘010 patent device from parallel walls to tapered walls involves a mere routine change in shape to one skilled in the art. The Examiner alleges that the indentations and raised areas of the ‘010 patent can be different shapes (see col. 5, lines 40-50). The Examiner alleges that the ‘010 patent teaches decreasing or minimizing contact between the particles and the surface of the ‘010 patent device. The Examiner further alleges that a portion of the specification of the instant application implies that the sloped/tapered shape of the invention is not a critical feature. Applicant respectfully disagrees with the Examiner.

Applicant adopts the factual statements made in the Kladders Declaration and the related text of the March 11, 2009 response, and respectfully requests that the Examiner consider the evidence of record. The evidence of record establishes that: (i) the teachings of the prior art of record, alone or in combination, do not disclose or suggest sloped and/or tapered parabolic-shaped elevations and/or depressions in a repeating pattern of an egg-carton arrangement as recited in claim 1 of the instant application (Kladders Declaration at para. 7); and (ii) one skilled in the art would not be motivated to modify the raised areas and indentations of the ‘010 patent to be sloped and/or tapered as recited. (Kladders Declaration at para. 9.) Indeed, the evidence of record shows that the Examiner’s allegation is counter to the well-established and understood facts among skilled artisans that: (i) sloped and/or tapered walls are not an obvious design consideration; and (ii) sloped and/or tapered walls/grooves are not well known and are not commonly used with microtechnology fabrication. (Kladders Declaration at para. 9.) Moreover, as the ‘010 patent teaches away from modifying the raised areas and indentations of the device of the ‘010 patent to be sloped and/or tapered because

sloped and/or tapered raised areas and indentations would not minimize the contact between the particles and a surface as required by the teachings of the '010 patent (Kladders Declaration at para. 10.), to rely on a combination of the '010 patent, the '118 patent, and the '143 patent in rejecting independent claim 1 of the instant application would be legal error. MPEP §§ 2141.02 (VI) and 2145 (X)(D) (prior art must be considered in its entirety, including disclosures that teach away from the claims.)

The evidence of record establishes that the Examiner's allegation that one skilled in the art would modify the device of the '010 patent to have different combinations of shapes and sizes, thereby producing different contact areas, not all of which would be equal and not all of which would minimize contact between the particle and the surface area, is inconsistent with the teachings of the '010 patent. (Kladders Declaration at paras. 7, 9, and 10.) For the sake of argument, even if one skilled in the art modified the shape and/or size of the device of the '010 patent (which Applicant does not concede), Applicant submits that one skilled in the art would maintain the principle of minimizing the contact between the particles and a surface of the device of the '010 patent. For example, one skilled in the art may employ the principles of congruence when modifying components such that contact is minimized as aforementioned.

Moreover, the evidence of record establishes that: (i) the '010 patent device does not work equally well as sloped and/or tapered parabolic-shaped elevations and/or depressions, and (ii) the specification of the instant application states the unexpected results of the sloped and/or tapered shape of the invention, and, thus, that the sloped/tapered shape of the invention is a critical feature. (Kladders Declaration at para. 8.) The aforementioned structural differences between the '010 patent device and the present invention as recited in claim 1 are critical because the structure of the surface walls affects the amount of interaction between the particles and the inhaler surface. The Kladders Declaration recites relevant portions of the specification of the instant application to emphasize how sloped/tapered elevations and/or depressions as recited in claim 1 are critical because such elevations and/or depressions are optimal, and display unexpected results:

- (i) [s]urprisingly, it has now been found that powder inhalers in which at least part of the inner surfaces which may come into contact with the powder aerosol are provided with a micro- or nano-structured surface, do not have worse delivery characteristics than powder inhalers with a smooth inner surface in these areas. (Page 5, lines 25-30, emphasis added.)

- (ii) [t]he properties of the surfaces thus obtained are optimum when the elevations have rounded tips. (Page 22, lines 1-5, emphasis added.)

(Kladders Declaration at para. 8.)

In view of the above, Applicant submits that the '010 patent does not cure the aforementioned deficiencies of the '118 patent. The '143 patent: (i) lacks any teaching of a sloped and/or tapered parabolic-shaped elevation and/or depression as recited in independent claim 1 of the instant application, and (ii) does not overcome the teach away of the '010 patent. Thus, the '143 patent does not cure the aforementioned deficiencies of the '118 and '010 patents. As such, the teachings of the '118 patent, the '010 patent, and the '143 patent do not result in the present invention as recited in claim 1.

Because the alleged combination of the cited prior art does not result in the invention of claim 1, Applicant submits that the Examiner is improperly looking to the specification of the instant application for such teachings, and that the Examiner has failed to present a prima facie case of obviousness. Specifically, because the '118 patent, the '010 patent, and the '143 patent: (i) fail to provide motivation for modifying the grooves/raised areas of the '010 patent; and (ii) do not disclose or suggest sloped and/or tapered elevations and/or depressions as recited in claim 1, Applicant submits that the Examiner is improperly looking to the specification for the teachings regarding the subject limitation. Generally, according to MPEP §2142, “[t]he tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process.” However, according to MPEP §2142, an exception to the general rule exists where “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (Emphasis added.) When reviewing prior art, the Examiner must take “into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure.” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (Emphasis added.). As aforementioned, the Examiner is in fact looking to the disclosure of the instant application for facts and/or motivation rather than to the prior art because the prior art provides no motivation for the alleged modification, and does not disclose or suggest sloped and/or tapered elevations and/or depressions as recited in claim 1.

In view of the above, claim 1 is patentable. As claims 2-7, 9, and 10 depend from independent claim 1, and recite additional patentable features, the subject dependent claims are, therefore, likewise patentable.

In the December 16, 2008 Office Action at page 5, the Examiner has rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over the '118 patent, the '010 patent, and the '143 patent in further view of U.S. Patent No. 4,889,114 ("the '114 patent"). The reasons for patentability of independent claim 1, from which claim 8 depends, over the '118 patent, the '010 patent, and the '143 patent as discussed above apply with equal weight to claim 8. The '114 patent: (i) lacks any teaching of a sloped and/or tapered parabolic-shaped elevation and/or depression as recited in independent claim 1 of the instant application, and (ii) does not overcome the teach away of the '010 patent. Thus, the '114 patent does not cure the aforementioned deficiencies regarding independent claim 1, and independent claim 1 is patentable. As claim 8 depends from independent claim 1, and recites additional patentable features, the subject dependent claim is, therefore, likewise patentable.


In view of the above, Applicant respectfully requests that the Examiner's §103 rejections be withdrawn.

**Conclusion:**

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. The fees for the petition and RCE are included herewith. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

Respectfully submitted,

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